

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Susumu TAKUMAI, *et al.*

Serial No.: 10/585,655

Filed: 07 July 2006

Title: SPEAKER SYSTEM

Group Art Unit: 2614

Examiner: D. Faulk

Attorney Docket No.: YAMA-0134

Confirmation No.: 5541

VIA EFS-WEB
17 January 2010

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

PETITION FOR WITHDRAWAL OF IMPROPER RESTRICTION
UNDER RULE 181

Sir:

Applicants petition to the Director to have the examiner withdraw the Restriction. This Petition is timely filed since the second Restriction is not made final yet.

No fee is believed to be due. If a fee is required, however, the Commissioner is authorized to charge an appropriate amount to Deposit Account No. 18-2056.

STATEMENT OF FACES

1. The examiner issued a Species requirement among two groups in the first Restriction dated 03 April 2009:

Group 1 (For claim 1):Species 1 (claim 2);
Species 2 (claim 3);
Species 3 (claim 4); and
Group 2 (For claim 5):Species 1 (claim 6);
Species 2 (claim 7);
Species 3 (claim 8).
2. In the reply to the first Restriction, applicants traversed the restriction on the ground that the species requirement is improperly grouped essentially because the claims themselves are never species, relying on MPEP § 806.04(e), and explained why the claims should not be restricted in the manner set forth by the examiner. See the first Election dated 03 July 2009, at pages 6-7.
3. In response, the examiner states that the restriction is proper and thus maintain the same restriction under PCT Rule 13.1, namely restricting the claims based on the species lacking unity of invention. See Detailed Action, page 2, 1st & 2nd ¶¶ of the second Restriction.
4. In the reply to the second Restriction, applicants elected claim 2 from Group 1 and claim 6 from Group II with traverse. See the second Election concurrently filed herewith.

PETITION

Applicants respectfully urge the Director to have the examiner withdraw the Restriction (species requirement) because claims 2-4 and 6-8 simply are not species, and it is improper to restrict the dependent claims from the independent from which they depend under PCT Rule 13.1.

First, as explained in the first Election, requiring an election of species based only on the claims is facially improper as the CLAIMS THEMSELVES ARE NEVER SPECIES. See MPEP § 806.04(e). If the examiner wishes to make a proper species requirement, the examiner should issue a proper species requirement based on the illustrated embodiments. The present application illustrates three embodiments, namely the embodiments of Fig. 1A and the embodiment of Figs. 2A-2C, with respect to the speaker configuration. Fig. 1A illustrates two embodiments differing only in the center channel configuration (C system channel 1 that uses all the speakers versus C system channel 2 that only uses the central most speakers), while Figs. 2A-2C illustrate the third embodiment.

Second, as explained in the first Election, restriction based on species can be applied only if claims identified by the examiner are mutually exclusive. See MPEP § 806.04(f). Different species are mutually exclusive if one claim recites a limitation that is found in the first species but not in a second, while a second claim recites a limitation found only in the second species and not in the first species. Here, claims 1-13 are not mutually exclusive, because all of the features set forth in claims 1-13 are found in the embodiment of Figs. 2A-2C.

Moreover, claims 1-3 are GENERIC to all the illustrated species, while claim 4 reads on the embodiment of Figs. 2A-2C. Specifically, claim 2 is directed to left and right channel configuration that reads on both embodiments of Figs. 1A and 2A-2C. Claim 3 is directed to the center channel configuration that also reads on both embodiments of Figs. 1A and 2A-2C. Since claim 2 is reciting the left and right channel configuration and claim 3 is reciting the center channel configuration, these features are not mutually exclusive since they can be combined together, as evidenced by claims 12 and 13. Since the features set forth in claims 2-4 are usable together (as they are directed to the same embodiment) they are not mutually exclusive. Thus, they cannot be categorized as species. The examiner clearly has improperly categorized different aspects of the same embodiment as species. Similarly, claims 10-13 clearly read on the embodiment of Figs. 2A-2C.

Claims 5-9 are directed to the circuits (Figs. 1B and 3) of the embodiments of Figs. 1A and 2A-2C. Since Fig. 1B is directly tied to the embodiment of Fig. 1A and Fig. 3 is directly tied to the embodiment of 2A-2C, by electing the embodiment of Fig. 2A-2C, applicants also elect the embodiment of Fig. 3 with respect to the circuit.

Claim 5 is also generic. Indeed, in all three embodiments (see Fig. 1A and 2A-C), the passing frequency band of **the left and right channel** reproduction regions decreases from the speakers positioned at opposite end portions of the speaker array to the speaker or speakers positioned at a central portion of the speaker array. Referring to Fig. 2A, the passing frequency band of **the center channel** reproduction region increases from the speakers positioned at the peripheral region of the speaker array to the speaker or speakers positioned at a central region of the speaker array.

Third, the examiner's response to the first Election is that applicants' arguments are misplaced because the examiner is basing the restriction on PCT Rule 13.1 and not according to the U.S. restriction requirement.

If that is indeed the case, applicants submit that the species restriction under the unity of invention requirement under the PCT is still improper because the **unity of invention requirements are directed solely between different independent claims and not between the independent claim and the claims depending from it**. There is no such thing as a restriction based on species under the unity of invention requirement. Indeed, PCT Rule 13.4 explicitly permits a reasonable number of **dependent claims**, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention. See also MPEP § 1850, Section II, ¶6, which explicitly states that ***[u]nity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.***

Regardless of whether the examiner restricts based on the unity of invention requirement under the PCT or the U.S. restriction requirement, the examiner's species requirement is simply improper for the foregoing reasons. Applicants thus urge the Director to have the examiner withdraw the Restriction.

Respectfully submitted,

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17 JANUARY 2010

DATE

/Lyle Kimms/

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